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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,793	09/28/2001	Takatsugu Nakazawa	P21331	2871

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EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,793

Applicant(s)

NAKAZAWA ET AL.

Examiner

Steven Ashburn

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

MH
~~Claim 7, 14, 21 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *Dragon Quest IV* by Enix America, Inc (1990) as described in Dan Gonzales, *Dragon Quest IV (NES) Manual*, (June 4, 2003) in view of claims 1-59 of copending Application No. 09/964,801.~~

Claims 7, 14, 21 and 28 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of copending Application No. 09/964,801 in view of *Dragon Quest IV* by Enix America, Inc (1990) as described in Dan Gonzales, *Dragon Quest IV (NES) Manual*, (June 4, 2003).

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Application No. 09/964,801 claims a video game that displays the action order of all the characters participating in the battle, including player characters and enemy characters. *Dragon Quest IV* provides a video game in which a player can selectively switch which characters participate in a battle during the battle. In view of *Dragon Quest IV*, it would have been obvious to an artisan at the time of the invention to modify the battle game claimed in 09/964,801 to add the feature of allowing a player to selectively switch which characters participate in a battle during the battle.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 8-10, 12, 13, 15-17, 19, 20, 22- 24, 26, 27, and 29-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Dragon Quest IV* by Enix America, Inc (1990) as described in Dan Gonzales, *Dragon Quest IV (NES) Manual*, (June 4, 2003). See, e.g., Gonzales, pp. 7-9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 11, 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Tanibuchi et al. U.S. Patent 6,475,084 B2 (Nov. 5, 2002).

In regards to claims 4, 11, 18 and 25: *Dragon Quest IV* describes a video game program comprising structured data stored on a computer-readable storage medium for execution by a programmable processor wherein the processor generates an interactive game, including audio and video outputs, in response to player inputs received through computer input devices. The game teaches all the claims except displaying information of characters in the list on a subscreen including bodily powers and magical powers.

Tanibuchi discloses an analogous video game in allowing the replacement of characters. The game includes a subscreen for replacing characters and includes character names and abilities. *See fig. 10*. Notably, although *Tanibuchi* exemplifies the system as a baseball game, it suggests applying it to other types of games. *See col. 11:58-12:7*.

In view of *Tanibuchi*, it would have been obvious to an artisan at the time of the invention to modify *Dragon Quest IV*, wherein a subscreen displays replacement characters possessing bodily and magical powers, to add the feature of displaying character information, including player bodily powers and magical powers, in a list on the subscreen. As suggested by *Tanibuchi*, providing information concerning replacement character's abilities enhances the game by permitting users to refer to information concerning the replacement characters. *See col. 12:61-67*.

Claims 7, 14, 21 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Yoshikawa et al., U.S. Patent 6,347,994 B1 (Feb. 19, 2002).

Dragon Quest IV teaches all the features of the claims except displaying the action order of all the characters including player characters and enemy characters participating in the battle.

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Yoshikawa discloses an analogous video game system in which characters in a battle can be changed or reordered. *See col. 11:50-57*. In particular regards to the claims, the game displays the action order of all characters. *See col. 11:37-48*.

In view of *Yoshikawa*, it would have been obvious to an artisan at the time of the invention to modify the battle game described by *Dragon Quest IV*, wherein a plurality of characters participated in a battle, to display the action order of all the characters including player characters and enemy characters participating in the battle. As disclosed in *Yoshikawa*, the modification would enhance the game by indicating the order in which a battle will proceed after characters are changed or reordered. *See id.*

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Baker et al., U.S. Patent 6,106,399 (Aug. 22, 2000)

Dragon Quest IV clearly teaches all the feature of the claim except a storage system that stores a program allowing a plurality of players to participate in the video game though a network.

Baker discloses an analogous multi-user, Internet role playing game system. It teaches that it was known in the art at the time of the invention to provide a storage system that stores a program allowing a plurality of players to participate in the video game though a network. *See col. 4:11-5:10*.

In view of *Baker*, it would have been obvious to an artisan at the time of the invention to modify the *Dragon Quest IV*, wherein a plurality of characters participate, to add the feature of a storage system that stores a program allowing a plurality of players to participate in the video game though a network. As suggested by *Baker*, the modification would enhance the game by allowing multiple players to participate and interact in a constantly changing and expanding virtual world, and thereby provide a more entertaining game. *See col. 4:65-5:10*.

Prior Art, Not Relied On

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The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure: *Dragon Warrior IV* downloaded from <http://gamefaqs.com/console/nes/data/7690.html> on September 30, 2003 describes release data for *Dragon Quest IV*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9302 for regular communications and 703 872 9303 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1078.

s.a.

October 17, 2003



**MARK SAGER
PRIMARY EXAMINER**